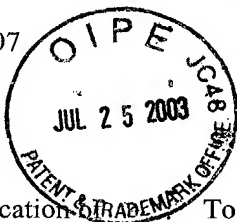


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1771-

Attorney Docket No. P21591

In re application of Toshio MATSUMOTO

Serial No. : 10/005,673

Group Art Unit: 1771

Filed : December 7, 2001

Examiner: V.S. Change

For : POROUS SINTERED BODY OF CALCIUM PHOSPHATE-BASED  
CERAMIC AND METHOD FOR PRODUCING SAME

RECEIVED  
JUL 29 2003  
GROUP 1700

Mail Stop Non-Fee  
COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Transmitted herewith is an election with traverse in the above-captioned application.

- ☐ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.
- ☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.
- ☐ A Request for Extension of Time.
- ☒ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 15	20*	0	x 9=	\$	x 18=	\$0.00
Indep. Claims: 2	*3*	0	x 42=	\$	x 84=	\$0.00
Multiple Dependent Claims Presented			+140=	\$	+280=	\$0.00
Extension Fees for Month				\$		\$0.00
Total:				\$	Total:	\$0.00

\*If less than 20, write 20

\*\*If less than 3, write 3

Please charge my Deposit Account No. 19-0089 in the amount of \$\_\_\_\_\_.

N/A A Check in the amount of \$\_\_\_\_\_ to cover the \*filing/extension\* fee is included.

- ☒ The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.
- ☒ Any additional filing fees required under 37 C.F.R. 1.16.
- ☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136) (a)(3)

Bruce H. Bernstein  
Reg. No. 28,394

33,084



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RECEIVED  
JUL 29 2003  
GROUP 1700

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Toshio MATSUMOTO

Group Art Unit: 1771

Serial No : 10/005,673

Examiner: V.S. Change

Filed : December 7, 2001

For : POROUS SINTERED BODY OF CALCIUM PHOSPHATE-BASED  
CERAMIC AND METHOD FOR PRODUCING SAME

**ELECTION WITH TRAVERSE**

Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

Sir :

Applicant responds herein to the Restriction Requirement mailed June 25, 2003.

Inasmuch as this Election With Traverse is being submitted within the one-month shortened statutory period set in the Restriction Requirement to expire on July 25, 2003, Applicant respectfully submits that no extension of time should be necessary. If the Commissioner determines that an extension of time and/or a fee is necessary, the same is hereby requested and the Commissioner is authorized to charge any necessary fees to maintain the pendency of this application to deposit account No. 19-0089.

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### **SUMMARY OF RESTRICTION REQUIREMENT**

The Restriction Requirement requires election under 35 U.S.C. § 121 between the following groups:

Group I: Claims 1-4, drawn to a porous sintered ceramic (classified in class 428, subclass 304.4); and

Group II: Claims 5-15, drawn to a method for producing a porous sintered ceramic (classified in class 264, subclass 434).

The Restriction Requirement states that the groups are related as process of making and product made and that the claimed process allegedly can be used to make other and materially different products such as a non-phosphate ceramic.

### **ELECTION**

In order to be responsive to the Restriction Requirement, Applicant elects Group I (claims 1-4), with traverse.

### **TRAVERSE**

Notwithstanding the election of Group I in order to be responsive to the requirement for election, Applicant respectfully traverses this requirement.

Applicant notes that the sole reason set forth for restriction in this case is that the claimed process could be used to make a non-phosphate ceramic. However, each of claims 5-15 (Group II) requires, *inter alia*, a calcium-phosphate-based ceramic as do claims 1-4 (Group I). Thus, Applicant respectfully submits that the Restriction Requirement fails the basic test set forth in

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MPEP 806.05(f).

In addition, the requirement for restriction omits one of the two criteria of a proper requirement as now established by U.S. Patent and Trademark Office policy, as set forth in MPEP 803 (Revision 8, May 1988), viz. that "an appropriate explanation" must be advanced by the Examiner as to the existence of a "serious burden" if a restriction were not required. Due to the aforementioned omission, it is respectfully submitted that the requirement for restriction is improper and, consequently, its withdrawal is respectfully requested.

Because a search of each of the inventions would appear to be at least related, and should certainly overlap if not actually be coextensive, there would be no serious burden on the Examiner to examine all of the claims in this application. For this reason, and consistent with Office policy set forth in MPEP 803, Applicant respectfully requests that the Examiner reconsider and withdraw the requirement for restriction.

Therefore, Applicant respectfully requests that the Restriction Requirement be reconsidered and withdrawn, in view of the applicable standards and the lack of a serious burden on the Patent Office and the lack of material differences between the Groups. Applicants also request that even if the restriction requirement is initially maintained, if the product claims are found to be allowable, the process claims which have the recitations of the allowed product claims should be rejoined.

In view of the foregoing, it is respectfully requested that the Examiner seriously reconsider the requirement for election, and withdraw the same so as to give an examination on the merits on all of the claims pending in this application.

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CONCLUSION

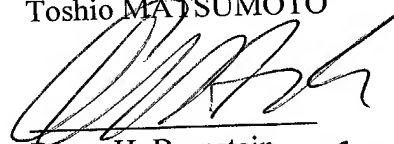
For the reasons discussed above, it is respectfully submitted that the requirement for election of species is improper and should be withdrawn.

Withdrawal of the requirement for election of species with the examination of all claims pending in this application, i.e., claims 1-15, is respectfully requested.

Favorable consideration with early allowance of claims 1-15 is most earnestly requested

Should the Examiner have any questions or comments regarding this matter, the undersigned may be contacted at the below-listed telephone number.

Respectfully submitted,  
Toshio MATSUMOTO



Bruce H. Bernstein  
Reg. No. 29,027

*By No. 33,094*

July 25, 2003  
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